



Banner &amp; Witcoff Case No. 3797.80030

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Khurshed Mazhar et al. )

Serial No. 09/411,171 )

Art Unit: 2756

Filed: October 1, 1999 )

Examiner: \_\_\_\_\_

For: Windows Radio Toolbar )

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OFFICE OF PETITIONS

**PETITION UNDER 37 CFR 1.183  
TO WAIVE REQUIREMENT OF STATEMENT OF LAST KNOWN ADDRESS  
OF NON-SIGNING INVENTOR UNDER 37 CFR 1.47(A)**

Assistant Commissioner of Patents  
Box DAC  
Washington, DC 20231

Dear Sir:

Applicants submit this 37 CFR 1.183 Petition as suggested in the Decision mailed June 20, 2000. In short, this petition requests that the PTO waive the requirement under 37 CFR 1.47(a) to provide a statement of the last known address of the non-signing inventor.

A grantable petition under 37 CFR 1.183 requires:

1. Showing of extraordinary circumstances where justice requires the suspension or waiver.
2. Petition fee; 37 CFR 1.17(h).
3. Prompt and diligent filing.
4. Compliance with any requirement of the regulation in question which is not suspended or waived or with such other requirements

as may be specifically imposed.

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Applicants respectfully submit that the present Petition satisfies these requirements.

Showing of extraordinary circumstances  
where justice requires the suspension or waiver

The previously submitted declaration of D. Bartley Eppenauer—the in-house attorney for the assignee—provides the detailed proof of the pertinent facts in support of the petition. As discussed in the attached declaration, neither the assignee nor the inventors have a last-known address for inventor Kevin Warne.

Mr. Warne's last-known employer is Harris & Associates, whose telephone number is (206) 232-9330. Unfortunately, the principal at Harris & Associates, Ray Murphy, would not divulge Mr. Warne's home address or provide other contact information.

Since Applicants have no way of contacting Mr. Warne or identifying his last known address, Applicants respectfully submit this constitutes a sufficient showing of extraordinary circumstances where justice requires the suspension or waiver of the provision of 37 CFR 1.47(a) requiring a statement of the last known address of the non-signing inventor.

Petition fee; 37 CFR 1.17(h)

Please charge deposit account no. 19-0733 in the amount of \$130 to cover the fee for the present Petition.

Prompt and diligent filing

Applicants' representative prepared and filed the present petition within the time period to respond to the Decision on Applicants' 37 CFR 1.47(a) petition. Furthermore, Applicants' representative filed this Petition within days after receiving an executed declaration from the other inventors.

Compliance with any requirement of the regulation in question  
which is not suspended or waived

A grantable petition under 37 CFR 1.47(a) requires:

1. proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers;
2. an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
3. the petition fee; and
4. a statement of the last known address of the non-signing inventor.

As discussed in Applicants' Request for Reconsideration, Applicants have complied with all other requirements of 37 CFR 1.47(a), except for item no. (4), which is the subject of the present 37 CFR 1.183 Petition.


For the foregoing reasons, Applicants respectfully request that this petition be granted.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: November 6, 2000

By:



Timothy C. Meece (Reg. No. 38,553)  
Banner & Witcoff, Ltd.  
10 South Wacker Drive  
Suite 3000  
Chicago, Illinois 60606  
Tel. (312) 715-1000

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**DECLARATION OF D. BARTLEY EPPENAUER  
IN SUPPORT OF RULE 1.47 PETITION  
TO FILE APPLICATION WHEN INVENTOR CANNOT BE REACHED**

I, D. Bartley Eppenauer, hereby state as follows:

1. I am an in-house patent attorney for Microsoft Corporation, who is the assignee of this application. And, I am the Microsoft attorney responsible for supervising prosecution of this application.

2. Kevin Warne is one of the named inventors on this application. For a period of time prior to April 9, 1999, Mr. Warne provided consulting services to Microsoft. As a result of Mr. Warne's work for Microsoft, the other inventors on this case believed that Mr. Warne should be named as a co-inventor.

3. Shortly after we learned that Mr. Warne should be named as a co-inventor, a paralegal with whom I work (Kymerie Schmidt) and I made numerous attempts to contact Mr. Warne and have him review the patent application.

4. We attempted to contact him via email. However, Mr. Warne did not have an internal Microsoft email address.

5. Since Microsoft did not have a home address for Mr. Warne, we asked the inventors if they knew where Mr. Warne was or how to contact him.

One of the inventors, Mr. Mazhar, thought that Mr. Warne went to work for Real Networks.

6. On or about August 19, 1999, I tried to call Mr. Warne at home at (425) 576-0860. I was unable to reach Mr. Warne at home, so I then tried to call him at Real Networks. The receptionist said that no one by the name of Kevin Warne had previously worked or currently works at Real Networks.

7. I called Mr. Warne's former employer, Harris & Associates, at (206) 232-9330. I spoke with a secretary who confirmed that Mr. Warne's home-telephone number was (425) 576-0860.

8. I called Mr. Warne at this home-telephone number and left a message on his answering machine. Mr. Warne did not return my call.

9. Ms. Schmidt called Mr. Warne again to follow up on or about September 27, 1999. There was no answer and there was no information on the answering-machine recording to indicate whether or not Mr. Warne lived there.

10. Ms. Schmidt then proceeded to call directory assistance in an attempt to find Mr. Warne's current telephone number. Directory assistance did not have a telephone number for Mr. Warne.

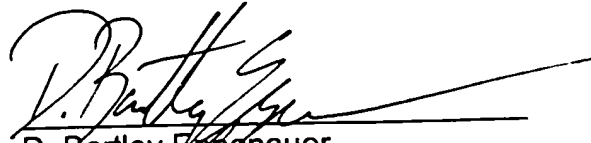
11. I again called Mr. Warne's former employer, Harris & Associates, at (206) 232-9330. This time I spoke with a principal of Harris & Associates—Ray Murphy. Mr. Murphy refused to divulge Mr. Warne's home address or provide other contact information.

I declare under the penalty of perjury that the statements made by me in this declaration are true and correct.

Respectfully submitted,

Date: March 21, 2000

By:

A handwritten signature in dark ink, appearing to read 'D. Bartley Eppenhauer', written over a horizontal line.

D. Bartley Eppenhauer  
Microsoft Corporation  
One Microsoft Way  
Redmond, WA 98052  
Reg. No. 35499  
Tel. 206-703-0645

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OFFICE OF PETITIONS

**REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR 1.47(A)**

Assistant Commissioner of Patents  
Box DAC  
Washington, DC 20231

Dear Sir:

Applicants submit this request for reconsideration in response to the Decision mailed June 20, 2000.

As instructed in the Decision, this Request only address the deficiencies noted in the Decision.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers;
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The Decision indicated that Applicants lack items (2) and (4).

In response to deficiency no. 2, Applicants submit herewith a new declaration, which identifies Kevin Warne as an inventor. As per the instructions contained in the Decision, the signature block for Mr. Warne is un-signed/blank.

As to deficiency no. 4, Applicants are unaware of any address for Mr. Warne. Consequently, as suggested in the Decision, Applicants submit herewith a petition under 37 CFR 1.183, requesting the requirement of providing the known address for the inventor under 37 CFR 1.47(a) be suspended in this instance. The petition is accompanied authorization to pay the petition fee from our deposit account.

Applicants thank the Supervisory Petition Examiner for her instructions, which enabled Applicants to overcome the deficiencies identified in the Petition.

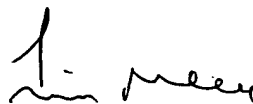
For the foregoing reasons, Applicants respectfully request that this petition be granted.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: November 6, 2000

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